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# 8

In re Application of :  
Horst Dollinger et al :  
Serial No.: 09/981,025 : PETITION DECISION  
Filed: October 16, 2001 :  
Attorney Docket No.: 1/1154 :

This is a decision on the petition under 37 CFR 1.144, filed June 24, 2003, requesting review of a restriction requirement.

#### BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on October 16, 2001. The examiner assigned to the application mailed a first Office action to applicants on December 17, 2002, setting a one month shortened statutory period for reply, and setting forth a restriction requirement as follows:

Group I, claims 1-27, drawn to a compound, its pharmaceutical composition and method of making;

Group II, claims 28-31, drawn to a method of treating various diseases and/or conditions.

The examiner argued that the Groups were related as product and process of use and that the process could be practiced with other compounds or compositions. The examiner also required an election of species within Group I, if elected.

Applicants replied on January 21, 2003, electing Group I with traverse arguing that there was no undue examination burden to examine both groups, but requesting rejoinder if the requirement is maintained and the product claims are found allowable. Applicants also elected a species, as required, indicating that claims 1-16 and 21-31 read on the elected species.

On April 3, 2003, the examiner mailed Office action on the merits of the elected species. The examiner maintained the restriction requirement and election of species and replied to applicants'

traversal thereof. The requirement was made Final. The examiner further indicated the elected species as allowable, but rejected claims 1-16 and 21-27 as unpatentable in view of Esser et al which teaches various other species set forth in the claims (see specifically Examples 16, 55 and 61). Applicants then filed this petition on June 24, 2003.

## DISCUSSION

Applicants' petition appears to be directed only to the election of species requirement, although it is noted that rejoinder of the claims has been requested should the product claims be found allowable. Applicants refer to M.P.E.P. 803.02 practice with regard to an election of species.

### 803.02 Restriction . Markush Claims PRACTICE RE MARKUSH-TYPE CLAIMS

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

This subsection deals with Markush-type generic claims which include a plurality of alternatively usable substances or members. In most cases, a recitation by enumeration is used because there is no appropriate or true generic language. A Markush-type claim can include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s). In applications containing claims of that nature, the examiner may require a provisional election of a single species prior to examination on the merits. The provisional election will be given effect in the event that the Markush-type claim should be found not allowable. Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable over the prior art, examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected and claims to the nonelected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species,

the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a *non-elected species*, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.


From the examiner's action it appears that the above guidelines have been followed. The elected species was examined and found to be free of the prior art and consideration then extended to additional related species, some of which were found to be obvious over the prior art. Thus the elected claims containing the elected species, as defined by applicants, have been properly examined. There is no requirement for the examiner to consider species in claims withdrawn from consideration until all species of the elected claims have been found allowable. Thus claims 17-20 remain properly withdrawn from consideration as do claims 28-31.

#### DECISION

Applicants' petition under 37 CFR 1.144 is **DENIED**.

**Applicants remain under obligation to file a proper reply to the Office action of April 3, 2003, within the time period as set therein or as may be extended under 37 CFR 1.136(a).**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

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